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United States Patent & Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 060091.00307
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____	Application Number: 10/829,473 Filed: April 22, 2004 First Named Inventor: Antti LAPPETELÄINEN Art Unit: 2617 Examiner: B.J. MILLER

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ Applicant/Inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed

☒ Attorney or agent of record.
Registration No. 43,828

☐ Attorney or agent acting under 37 CFR 1.34.
Reg. No. is acting under 37 CFR 1.34 _____

Arlene P. Neal
Signature

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Typed or printed name

703-720-7897
Telephone number

August 20, 2007
Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:
Antti LAPPETELÄINEN
Application No.: 10/829,473
Filed: April 22, 2004
For: TERMINAL SYSTEM AND RADIO RESOURCE CONTROL IN WIRELESS TELECOMMUNICATIONS SYSTEM

Confirmation No.: 6432
Art Unit: 2617
Examiner: B.J. MILLER
Attorney Dkt. No.: 060091.00307

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

August 20, 2007

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005 Official Gazette Notice, Applicants hereby submit this Pre-Appeal Brief Request for Review of the final rejections of claims 1-29 in the above identified application. Claims 1-29 were finally rejected in the Office Action dated April 19, 2007. Applicants filed a Response to the Final Office Action on July 13, 2007, and the Office issued an Advisory Action dated august 1, 2007 maintaining the final rejections of claims 1-29. Applicants hereby appeal these rejections and submit this Pre-Appeal Brief Request for Review. A Notice of Appeal is filed timely concurrently herewith. This Pre-Appeal Brief Request for Review is being timely filed. As will be discussed below, numerous clear errors exist in the final rejections that require withdrawal thereof.

Claims 1-21, 23, 25, 17, and 29 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,868,282 to Carlsson (hereinafter Carlsson). As outlined below, Carlsson fails to disclose or suggest each of elements of claims 1-21, 23, 25, 17, and 29. The failure of Carlsson to disclose each and every element of the present claims constitutes clear error.

Carlsson discloses a way in which subscriber identity information in a memory stored within a device, such as a mobile terminal, can be remotely used by a second independent device. In the case of a GSM terminal, for example, one terminal would be able to utilize the subscriber identity information contained in the SIM of another terminal by establishing a local communication link between the two terminals. The communication terminal, which is using the remote subscriber identity information from an independent device receives a command to use the remote subscriber identity information. This initial command can be entered by a user using the normal input/output (I/O) capabilities of the communication terminal, or it could be a command received over a

communication link from the independent device which is going to supply the remote subscriber identity information. A local communication link is established between the two devices. Remote subscriber identity information is received over the local communication link and the communication terminal, which is using the remote subscriber identity information can register with the network using that information. See Col. 1, lines 41 to 61.

Figures 1A and 1B illustrate the overall method of Carlsson. At step 101, a user decides to use the remote SIM function. The user enters a command through the I/O interface of the mobile station or other terminal at step 102. At step 108, the other mobile station or terminal, which is to supply the remote subscriber identity information, receives a command to supply the information. This command could be received from a user via the I/O of the supplying device. Alternatively, the supplying mobile station could receive some type of command from the using station, specifically requesting the use of the remote subscriber identity information. At step 110, a check is made to determine if the supplying mobile station is registered with the network. If so, it will be necessary for the supplying mobile station to de-register at step 112. This de-registration is necessary because the network prohibits two stations with the same subscriber identity from being registered on the network at the same time. Currently, wireless systems are set up with this prohibition to prevent unlawful or illegitimate use of subscriber accounts.

Applicants submit that the rejection of claims 1-21, 23, 25, 17, and 29 under 35 U.S.C. §102(e) based on the teachings of Carlsson is clearly erroneous. Applicants submit that Carlsson fails to teach or suggest each of the features recited in the pending claims. All of claims 1-21, 23, 25, 17, and 29, in part, recites that a radio link is requested from the subscriber terminal, the radio link being directed from the infrastructure to the at least one sub-terminal. Carlsson does not teach or suggest this feature.

The Office Action alleged that this feature of the pending claims is anticipated by Col. 4, lines 18-21 and Col. 6, lines 13-15 and 22-25 of Carlsson. Col. 4, lines 18-21 of Carlsson discloses alternatively, the supplying mobile station could receive some type of command from the "using" station, specifically requesting the use of the remote subscriber identity information. Col. 4, lines 18-21 of Carlsson also discloses that for purposes of the rest of this disclosure, it will be assumed that the subscriber has entered a command on the terminal that is to supply the remote subscriber identity information. This section of Carlsson merely describes a functionality where the supplying mobile station receives a command from the using station, such that the command requests the use of the remote subscriber identity information.

Col. 6, lines 13-15 and 22-25 of Carlsson discloses that if a mobile station A (the supplying mobile station) is already registered with the network, the CPU sends a request to the radio communication section to transmit a request to de-register from the network at step 2. The RF black within the radio communication section transmits the de-registration message at step 3 of Carlsson. At step 4 of Carlsson, the CPU within the processor system requests that the local communication interface set up a secure communication link with mobile station B (the "using" mobile station). In this example, mobile station A sends to mobile station B a "supply remote SIM mode started" message so that mobile station B can establish a remote SIM operation. Thus, this section of Carlsson merely describes a functionality where a CPU sends a request for de-registering the supplying mobile station from the network.

The Office Action alleged that requesting the use of remote subscriber identity as disclosed in Carlsson is equivalent to requesting a radio link from the subscriber terminal, the radio link being directed from the infrastructure to the at least one sub-terminal, as recited in the pending claims. The Office Action also alleged that "the request for remote subscriber identity causes the supplying terminal to de-register from the network, which requires a radio link to be directed between the infrastructure and the supplying terminal." While the request for remote subscriber identity causes the supplying terminal to de-register from the network, which requires a radio link to be directed between the infrastructure and the supplying terminal, there is no teaching or suggestion in Carlsson that the radio link requested is directed from the infrastructure to the at least one sub-terminal, as recited in the pending claims.

Carlsson is directed to transferring subscriber identity from one mobile station to another over a local communication link in order to reduce the need for transferring the SIM card physically between the two mobile stations. Otherwise, in Carlsson, the two mobile stations are independent. Carlsson also discloses the need for de-registration of the supplying device. This indicates that the supplying device of Carlsson is not capable of requesting a radio link for the using station, wherein the radio link is directed from the infrastructure to the using station, as recited in the presently pending claims. As is indicated in the cited passage of Carlsson, the de-registration is necessary because the network prohibits two stations with the same subscriber identity from being registered on the network at the same time.

Furthermore, all of claims 1-21, 23, 25, 17, and 29 recite that at least one of the signalling parameters is communicated between the sub-terminal and the infrastructure via the subscriber terminal. The Office Action cited Col. 5, lines 58-62 and Col. 6, lines 13-15 and 22-25 of Carlsson as teaching this feature. However, the cited section does not teach or suggest communicating

signaling parameters between the sub-terminal and the infrastructure via the subscriber terminal. Due to the de-registration of the supplying device in Carlsson communicating signalling parameters between a "using" station and infrastructure via a "supplying" device is not possible. Carlsson implicitly indicates that once the subscriber identity information is transferred to the using station, the using station operates independently of the supplying device. Therefore, the supplying device, in Carlsson, is not capable of requesting a radio link from the subscriber terminal, the radio link being directed from the infrastructure to the at least one sub-terminal. Therefore, Carlsson fails to disclose or suggest that a radio link is requested from the subscriber terminal, the radio link being directed from the infrastructure to the at least one sub-terminal and at least one of the signalling parameters is communicated between the sub-terminal and the infrastructure via the subscriber terminal, as recited in claims 1-21, 23, 25, 17 and 29.

With regards to the feature of generating signalling parameters for controlling the radio link between the subscriber terminal and the infrastructure, as recited in the pending claims, Col. 5, lines 58-62 of Carlsson (cited in the Office Action) does not teach or suggest this feature. Based and these differences between the presently pending claims and Carlsson, Applicants respectfully assert that the rejections under 35 U.S.C. 102(e) is in clear error and should be withdrawn because Carlsson fails to teach or suggest each feature of claims 1-21, 23, 25 17 and 29.

Claims 22, 24, 26 and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Carlsson in view of U.S. Patent Publication No. 2004/0048678 to De Torbal (hereinafter De Torbal). According to the Office Action, Carlsson teaches all of the elements of claims 22, 24, 26 and 28 except for generating a handover request in the subscriber terminal and performing simultaneous handovers of multiple subscribers. Therefore, the Office Action combined Carlsson and De Torbal to yield all of the elements of claims 22, 24, 26, and 28. The rejection is traversed as being based on references that fail to teach or suggest the combination of features recited in claims 1, 6, 11 and 13, upon which claims 22, 24, 26 and 28 depend.

De Torbal discloses that advance handover notice is given to a "target" base station of a group of mobile radio connections that will be soon be handed over to the target base station from a current, "serving" base station. This advance notice permits the target base station to reserve resources and prepare for the handovers of the mobile radio connections. In addition, the handover operation is initiated earlier than it would be otherwise. See at least the Abstract.

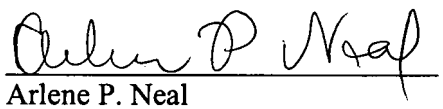
De Torbal does not cure any of the deficiencies of Carlsson, as outlined above. Specifically, De Torbal does not teach or suggest that a radio link is requested from the subscriber terminal, the radio link being directed from the infrastructure to the at least one sub-terminal and at least one of the

signalling parameters is communicated between the sub-terminal and the infrastructure via the subscriber terminal, as recited in claims 1, 6, 11 and 13, upon which claims 22, 24, 26 and 28 depend. Therefore, Applicants respectfully assert that the rejections under 35 U.S.C. 103(a) is in clear error and should be withdrawn because neither Carlsson nor De Torbal teaches or suggests each feature of claims 1, 6, 11 and 13, and hence dependent claims 22, 24, 26 and 28 thereon.

For all of the above noted reasons, it is strongly submitted that certain clear differences exist between the present invention as claimed in claims 1-29 and the prior art relied upon by the Examiner. It is further submitted that these differences are more than sufficient that the present invention would not have been anticipated or obvious to a person having ordinary skill in the art at the time the invention was made. This final rejection being in clear error, therefore, it is respectfully requested that the Examiner's decision be reversed in this case regarding the rejections of claims 1-29, and indicate the allowability of all of pending claims 1-29.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: PTO/SB/33 Form
Notice of Appeal
Petition for Extension of Time
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